

REMARKS/ARGUMENTS

The rejections presented in the Office action date June 3, 2004 have been considered. Claims 1-10 remain pending in the application. Reconsideration and allowance of the application is respectfully requested.

Claims 1-7 stand rejected under 35 U.S.C. §101. Claims 1, 4 and 6-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,073,104 to *Field* in view of U.S. Patent No. 5,666,553 to *Crozier*. Claims 2-3 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Field* as applied to claim 1, and in further view of U.S. Patent No. 6,151,588 to *Tozzoli et al.*

Claims 1-7 have been amended to indicate potentially inherent characteristics relative to the implementation of the claimed approach with a computing arrangement. These amendments have not been made in view of any Prior Art reference. Applicants respectfully submit that the Applicants have not intended to narrow, nor have the Applicants narrowed, the breadth of the claims as originally filed through the explanatory comments and/or amendments herein.

Based upon a telephone conversation between a Crawford Maunu PLLC patent attorney and Examiner Dass on November 30, 2004, it is the Applicants' understanding that the 35 U.S.C. §101 rejection should be overcome in view of the claim amendments. The Applicant would like to thank Examiner Dass for the Examiner's time and for the thorough explanation provided.

Applicants respectfully traverse the 35 U.S.C. §103 rejection of claim 7, as it is respectfully submitted that the Office Action has failed to state such a rejection in a manner commensurate with 35 U.S.C. §132 and further as indicated in M.P.E.P. §707.07(d), relative to the requirement that the statement of the rejection set forth all claims. Specifically, the Office Action is unclear as to which references are relied upon in making the rejection of claim 7. While the statement of rejection on page 2 of the Office Action references claims 1, 4 and 6-10, no mention of claim 7 is made in the discussion of the rejection. Further, the statement of rejection on page 5 of the Office Action references only claims 2, 3 and 5, making no mention of claim 7, yet claim 7 is discussed in connection with this statement of

rejection. For purposes of this response, Applicants have assumed that claim 7 stands rejected over the '104 reference in view of the '553 reference and of the '588 reference, as indicated relative to claims 2, 3 and 5 discussed on page 5 of the Office Action. Notwithstanding this assumption, Applicants request clarification in the context of a non-final communication, and further request an opportunity to respond thereto if it becomes necessary.

Applicants respectfully traverse the Section 103 rejections, each of which relies upon an improper modification of the '104 reference with the '553 reference, because the Office Action fails to adequately set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, as indicated in the M.P.E.P., the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, the M.P.E.P. further indicates that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In this instance, the Office Action failed to meet the criteria for establishing such a Section 103(a) rejection, as discussed below.

Applicants submit that the cited portions of the references fail to teach or suggest all of the claimed limitations of the present invention. Furthermore, the Office Action has failed to allege teachings that correspond to all of the claimed limitations. Beginning with the discussion of claims 1, 8 and 10 at the top of page 3 of the Office Action, no portion of the cited references has been asserted for teaching or suggesting claimed limitations directed generally to investment plan information, or specifically to defining an import specification identifying database format characteristics of investment plan information. Instead of addressing the claimed limitations of the present invention, the rejection in the Office Action is limited to discussion of asserted teachings relating to “defining export specification that defines what data items are in each field” This limited discussion fails to show how the cited portions of the '104 reference correspond to the above claimed limitations. For example, the cited export specification in the '104 reference appears limited in application to defining “what data items are in each field” (*see* column 8, line 67) and fail to teach or suggest an import specification identifying database format characteristics.

Regarding the discussion on page 3 of the Office Action offered in connection with limitations directed to transferring investment plan information to a central database, the cited

portions of the '104 reference do not appear to teach or suggest a central database accessible by investment contract sellers authorized by investment contract buyers to receive the plan information. It appears that the information stored in the "central database" in the cited portion of the '104 reference is provided by a seller, where available buyers can access the information (*i.e.*, in connection with the sale of patient claims). Furthermore, the "approved payor" referenced in the Office Action is not relevant to any authorization in the context of the claimed invention, contrary to the apparent assertion in the Office Action. In this regard, these cited portions of the '104 reference fail to teach or suggest limitations directed to investment plan information at a central database accessible by potential sellers as authorized by buyers (*e.g.*, where sellers can propose an investment contract for purchase by a buyer).

Regarding the discussion at page 3 of the Office Action offered in connection with claimed limitations directed to creating a proposed investment contract, Applicants reiterate that the cited portions of the '104 reference do not appear to teach or suggest limitations directed to investment contracts in the context of the present invention. The cited portions of the '104 reference, including column 5, lines 14-30 and 45-50 appear limited to the provision of a conduit via which sellers can provide data that can be accessed by potential buyers in a commercial paper program. The "contract" information cited in the '104 reference has not been asserted in the Office Action to be, created from proposed investment plan information received via a central database. Rather, upon brief review, the "contract" in the context of the '104 reference appears to be established between a special purpose entity (SPE) and a receivable seller. This "contract" is unrelated to a proposed investment contract as claimed in the present invention.

Furthermore, as acknowledged on page 3 of the Office Action, the primary '104 reference fails to teach or suggest limitations directed to a data import map, mapping data fields and/or a second database with predefined data fields. In an attempt to overcome this deficiency, the Office Action purports to modify the '104 reference with a disparate platform-based approach in the '553 reference. Applicants submit that this proposed modification is improper, for reasons discussed further below in connection with the lack of motivation for making such a modification. Moreover, the '553 reference's discussion of data sharing across

disparate computer platforms fails to teach or suggest limitations directed to data mapping in the context of investment and/or financial transactions.

The cited portions of the '588 reference discussed at page 5 of the Office Action also fail to teach or suggest limitations directed to seller authorized access to investment information in a central database. The cited portions of the '588 reference appear limited in application to an authorization code that is used as part of a communication between buyers and sellers, with the authorization pertaining to a particular contract. *See, e.g.*, column 13 lines 63-66, wherein an authorization code is implemented for providing authorization for a specific transaction between a buyer and seller. In this regard, these cited portions of the '588 reference do not appear to teach or suggest the authorization approach claimed in the present invention.

The rejections of each of the remaining dependent claims (2-7 and 9) fail for reasons including those discussed above in connection with limitations relating to independent claims 1, 8 and 10, in view of the Section 103 requirement that the references teach or suggest all of the claimed limitations. In this regard, further discussion of limitations in the dependent claims and otherwise is omitted for brevity. In view of the above, all of the Section 103 rejections fail to show teaching or suggestion of all of the claimed limitations and, therefore, fail to establish a *prima facie* case of obviousness. Applicants respectfully request that the Section 103 rejections be removed.

In addition to the above-discussed failures of the Section 103 rejections, the Office Action failed to cite evidence of motivation, from the prior art, for making the asserted modifications of the primary '104 reference. Relevant case law indicates that, without such evidence of motivation, the Section 103(a) rejection should be removed (*see, e.g., In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)). In this instance, regarding each of the independent claims, the Office Action failed to cite evidence of motivation for modifying the primary '104 reference to include the disparate computer application/platform data mapping of the '553 reference. That is, the Office Action failed to show how, or set forth why, one of skill in the art would look to the primary '104 reference at the time of its invention and modify the reference to achieve the disparate platform data sharing in the '553 reference.

In lieu of evidence from the prior art that would substantiate the proposed modification of the '104 reference, the Office Action restates the teachings of the secondary references. Specifically, the Office Action indicates on page 4 that it would have been obvious to combine the references "to accept data from a first computer application, and then mapping and translating the data to the formats expected by a second computer application." This asserted rationale fails to cite supporting evidence from the prior art and further does not address any problem with the '104 reference benefiting from such a modification or any other motivation for making the proposed modification. That is, the Office Action hasn't shown why one of skill in the art would look to modify the '104 reference with the disparate-platform-based mapping and translating of the '553 reference.

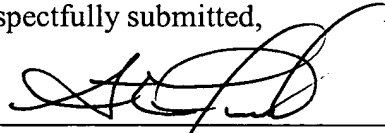
The Office Action further failed to cite evidence of motivation from the prior art for modifying the primary '104 reference with the '588 reference. Specifically, the asserted motivation (on page 5 of the Office Action) "to allow authorized user to access the system" and "to timely information the user(seller/buyer) of any changes in contract, approval, acceptance, etc." does not appear related to the authorization code in the cited portion of the '588 reference. The asserted motivation is therefore unrelated to the proposed modification of the '104 reference, to include the authorization code for executing a particular transaction component between a buyer and seller. Therefore, one of skill in the art would not be motivated as suggested in the Office Action.

In view of the above, the Applicants submit that the Office Action also failed to meet the motivation requirement for maintaining the Section 103(a) rejections; therefore, the Office Action failed to establish a *prima facie* case of obviousness and the Applicants request that the rejections be removed.

The Applicants respectfully submit that the pending claims are allowable over the cited prior art of record, and that the application is in condition for allowance. If the Examiner believes it necessary or otherwise helpful, the undersigned attorney of record may be contacted at (651) 686-6633 (x110) to discuss any issues related to this case.

Date: December 2, 2004

Respectfully submitted,



Steven R. Funk
Reg. No. 37,830

srf/ec

Encl.: Petition for Extension of Time